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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,957	09/03/2004	Alexander Shipp	117-517	1437
23117	7590	12/12/2006	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			RAYYAN, SUSAN F	
			ART UNIT	PAPER NUMBER
			2167	

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/500,957

Applicant(s)

SHIPP, ALEXANDER

Examiner

Susan F. Rayyan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 9-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments, see amendment, filed September 22, 2006, with respect to the rejection(s) of claim(s) 1, 7 under 35 USC 102(a) and the rejection of claims 2-6, 8-12 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of US Patent Application Publication Number 2004/0088570 issued to Guy William Welch Roberts et al ("Roberts").

Response to Applicants' arguments concerning the rejection of claims 1-12 under 35 U.S.C. 101 as directed to non-statutory subject matter.

2. Applicant argues in the response on page 6 that the determination allows the system (or user) to decide how the file is subsequently handled. This is very much a real world result. In response to applicants' argument, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Claims 1, 7 would provide a tangible result, for example, if the results of the subsequent handling were displayed to the user or stored and retrieved for use at a latter point in time. This would provide the "tangible" (real world) result. Examiner maintains the rejection of claims under 35 U.S.C. 101 as directed to non-statutory subject matter.

DETAILED ACTION

3. Claims 1, 3-7,9-13 are pending.
4. Claims 4,8 have been canceled and new claim 13 entered.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3-7,9 – 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 IV.B.2. (b) A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application. is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application.

Claims 1, 3-7,9-13 in view of the above cited MPEP sections, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application.

Claims 1,7 teach "means for generating data with regard to the file to characterize its identity ...", "means for selectively subjecting the file to a number of heuristic procedures ...", "means for determining ...whether the file can be regarded as safe", and "controlling the means b) such that the file, if the file is regarded as safe, is either subject to less thorough processing than if it were not regarded or not subject to processing by the means b) at all". The claim limitations determine whether a file contains or likely to contain malware and depending on the results, subjects the file to

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no further processing or less thorough processing. The claim simply determines and processes and therefore provides no tangible results.

Claim 13 teaches "a system for processing a computer file to determine whether it contains a virus or other malware ..., the system comprising "an engine that generates data ..."; "that processes the file ..."; "and that determines ...". The claim simply determines and therefore provides no tangible results.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims, 3-7,9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Application Publication Number 2004/0088570 issued to Guy William Welch Roberts et al ("Roberts").

As per claims 1,7, Roberts anticipates:

A system for processing a computer file to determine whether it contains a virus or other malware comprising:

a) means for generating data with regard to the file to characterize its identity and for thereby referencing a computer database to determine whether it is an instance of a

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known file (see paragraph 37, lines 8-13checksum equates to "characterize its identity and compare the checksum against new checksum);

b) means for selectively subjecting the file to a number of heuristic procedures to determine whether or not it contains, or is likely to contain, malware (paragraph 37-38, and Figure 6, Reference Number 42-48, generate a checksum of the file user requested and compare the checksum against stored checksum, if result is the same then there is no re-scanning however if the results are different the file is re-scanned for viruses); and c) means for determining, in dependence upon the record, if any, of the file in the database, whether the file can be regarded as safe in dependence on factors including the length of time which the database indicates that the file has been known without malware-containing instances of it being detected (paragraph 37, lines 8-18, checksum comparison and a mechanism which uses dates and other information to determine currency and status);

and for controlling the means b) such that the file, if the file is to be regarded as safe, is either subject to less thorough processing than if it were not so regarded or not subject to processing by the means b) at all (paragraph 38, lines 1-10, if a checksum indicates no change file supplied to user however if a change is detected the file is re-scanned for viruses).

As per claims 3,9 same as claim arguments above and Roberts anticipates:

wherein the means c) performs said determining of whether a file can be regarded as safe in dependence on factors including sources, recorded in the database, from which instances of the file have originated (paragraph 34, lines 1-6, Internet address)

As per claims 4,10, same as claim arguments above and Roberts anticipates:
performs said determining of whether a file can be regarded as safe in dependence on factors including the number of times, recorded in the database, instances of the file have been processed (paragraph 37, lines 8-18, checksum comparison and a mechanism which uses dates and other information to determine currency and status).

As per claims 5,11, same as claim arguments above and Roberts anticipates:
means for updating the database in dependence upon the result of the processing of the file by the means b) (paragraph 33, virus found actions include updating).

As per claims 6,12, same as claim arguments above and Roberts anticipates:
wherein the updating of the database, is operative in the event of the means b)
determining that the file contains, or is likely to contain, malware to delete the record of the file in the database or to update the record of the file in the database so that the file no longer is taken be safe (paragraph 33, virus found actions).

As per claim 13 Roberts anticipates:
an engine that generates data with regard to the file to characterize its identity and for thereby referencing a computer database to determine whether it is an instance of a known file(see paragraph 37, lines 8-13checksum equates to "characterize its identity and compare the checksum against new checksum);

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that processes the file by selectively subjecting the file to a number of heuristic procedures to determine whether or not it contains, or is likely to contain, malware (paragraph 37-38, and Figure 6, Reference Number 42-48, generate a checksum of the file user requested and compare the checksum against stored checksum, if result is the same then there is no re-scanning however if the results are different the file is re-scanned for viruses);

and that determines, in dependence upon the record, if any, of the file in the database, whether the file can be regarded as safe in dependence on factors including the length of time for which the database indicates that the file has been known without malware-containing instances of it being detected (paragraph 37, lines 8-18, checksum comparison and a mechanism which uses dates and other information to determine currency and status);

and for controlling the processing to which the file is subjected such that the file, if the file is to be regarded as safe, is either subject to less thorough processing than if it were not so regarded or not subject to the processing at all (paragraph 38, lines 1-10, if a checksum indicates no change file supplied to user however if a change is detected the file is re-scanned for viruses).

Contact Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Rayyan whose telephone number is (571) 272-1675. The examiner can normally be reached M-F: 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Susan Rayyan

December 6, 2006


JOHN COTTINGHAM
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